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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,957	11/17/2003	Jiro Moriyama	CFA00047US	4447

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EXAMINER

GARCIA JR, RENE

ART UNIT	PAPER NUMBER
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2853

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/715,957

Applicant(s)

MORIYAMA ET AL.

Examiner

Rene Garcia, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 05 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2 & 4-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Silverbrook et al. (US 2002/0080396).

Silverbrook et al. disclose the following:

*regarding claims 1 & 10, recording apparatus **/netpage printer, 601/** (fig. 11) and method for forming an image on a recording medium/**netpage, 1/** (fig. 1; paragraph 0216 see also paragraphs 0148 and 0218), comprising:

*recording means/**print engine controllers, 760/** (fig. 14; paragraph 0554) for performing recording by applying a recording material/**ink/** (paragraph 0243) onto the recording medium/**1/** (fig. 1), the recording means/**760/** recording at least one of a positional information image/**coded data, 3/** representing positional information (paragraph 0158; x & y coordinates) corresponding to the position where the positional information image/**coded data, 3/** is recorded and the other image/**graphic data, 2/** (fig. 1; paragraph 0129)

*control means/**processor, 750/** (fig. 14; paragraphs 0552 & 0553) for controlling the recording (paragraph 0220) such that the recording means/**760/** records the positional information image with a recording material/**infrared inks, IR-absorptive black ink/** capable of being detected by a predetermined detector/**netpage pen, 101/** (figs. 8 & 9; paragraph 0255), and

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said other image with another recording material/**inks**/ (paragraph 0243; cyan, magenta, yellow, black) incapable of being detected by the detector/**netpage pen, 101**/ (paragraph 0151 – cyan, magenta, yellow, black are non-infrared emitting)

*regarding claim 2, recording material/**infrared inks, IR-absorptive black ink**/ used for recording the positional information image/**coded data, 3**/ contains carbon (paragraphs 0584 – 0592; infrared dyes/**ink**/ contain carbon atoms), and the recording material (paragraph 0243; cyan, magenta, yellow, black) used for recording said other image/**graphic data, 2**/ is carbon-free (fig. 1)

*regarding claim 4, recording material for the positional information image/**coded data, 3**/ (fig. 1, paragraph 0129) is black/**IR-absorptive black ink**/ (paragraph 0223), and the recording material for said other image/**graphic data, 2**/ (fig. 1, paragraph 0129) is a plurality of recording materials/**inks**/ capable of recording a color image (paragraph 0243)

*regarding claim 5, plurality of recording materials/**inks**/ correspond to a plurality of colors including yellow, magenta, and cyan (paragraph 0243)

*regarding claim 6, plurality of recording materials/**inks**/ have a plurality of colors including yellow, magenta, cyan, and black (paragraph 0243)

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*regarding claim 7, positional information image/**coded data, 3/** (fig. 1) is expressed by a combination pattern of a plurality of spots to represent the positional information (figs. 6a, 6b & 6c)

*regarding claim 8, positional information/**coded data, 3/** is associated with coordinates on the recording medium/**netpage, 1/** (fig. 1; paragraph 0159; x & y coordinates)

*regarding claim 9, positional information/**coded data, 3/** is associated with coordinates on a virtual plane beyond the area of the recording medium/**netpage, 1/** (fig. 1; paragraph 0149; multiple pages can have same positional data & each page has unique page ID since recording medium is considered to be one page; paragraph 0157 – region to which a tag [tag ID – positional information] refers can be an arbitrary subregion of a page or other surface [virtual plane])

*regarding claim 11; recording medium/**netpage, 1/** (fig. 1) including:

*pattern image/**coded data, 2/** (figs. 1 & 6a, 6b, 6c; paragraph 0129) designating positions (paragraph 0158; x & y coordinates) at least thereon, the pattern image being/**2/** recorded by applying a first recording material/**ink/** capable of being detected by a predetermined detector/**netpage pen, 101/** (figs. 8 & 9; paragraph 0255)

*the other image/**graphic data, 2/** (fig. 1; paragraph 0129) recorded by applying a second recording material incapable of being detected by the detector/**101/**

*regarding claim 12, recording system comprising (fig. 14 – printer controller):

*recording apparatus/**netpage printer, 601/** (fig. 11) for performing recording by applying a recording material/**ink/** onto a recording medium/**netpage, 1/** (fig. 1) according to image data, the recording apparatus/**601/** recording positional information representing positions/**coded data, 3/** (fig. 1; paragraph 0129 & 0158) on at least the recording medium/**1/** and the other image/**graphic data, 2/** (fig. 1), the recording apparatus/**601/** including control means/**processor, 750/** (fig. 14; paragraphs 0552 & 0553) for controlling recording such that the positional information/**3/** is recorded with a recording material capable of being detected by a predetermined detector/**netpage pen, 101/** (figs. 8 & 9; paragraph 0255), and said the other image/**graphic data, 2/** (fig. 1) is recorded with a recording material incapable of being detected by the detector/**101/** (paragraph 0151 – cyan, magenta, yellow, black are non-infrared emitting)

*transmitting apparatus/**print controller, 656/** (fig. 15) for transmitting the image data to the recording apparatus/**netpage printer, 601/** (fig. 11), the transmitting apparatus including image data preparation means/**DSPs, 757/** (fig. 14; paragraph 0563) and image data transmission means/**IEEE 1394 Serial Interface, 659/** (fig. 14; paragraph 0569)

*regarding claim 13, program for controlling/**software/** (paragraph 0556) a recording apparatus/**netpage printer, 601/** (fig. 11) for recording an image by applying a recording material/**ink/** (paragraph 0243) onto a recording medium/**netpage, 1/** (fig. 1), the program performing:

*the recording step (paragraph 0567) of recording an positional information image/**coded data, 3/** corresponding to positional information representing positions (paragraph 0158; x & y

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coordinates) on at least the recording medium/**1/** and the other image/**graphic data, 3/**, on the recording medium/**1/** (fig. 1; paragraph 0129; paragraph 0220 – printing of combination of data)

*the control step (paragraph 0571) of controlling the recording step such that the positional information image is recorded with a recording material/**infrared inks, IR-absorptive black ink/** capable of being detected by a predetermined detector/**netpage pen, 101/** (figs. 8 & 9; paragraph 0255), and said the other image/**3/** is recorded with another recording material/**ink/** incapable of being detected by the detector/**101/** (paragraph 0151 – ink: cyan, magenta, yellow, black are non-infrared emitting)

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook et al. (US PG PUB 2002/0080396) in view of Tan et al. (US 6,613,403).

Silverbrook et al. disclose all of the claimed limitations except for the following:

*regarding claim 3, recording material used for recording the positional information image comprises one of a pigment ink containing carbon and a dye ink containing carbon, and the recording material used for recording said other image comprises one of a carbon-free pigment ink and a carbon-free dye ink

Silverbrook et al. did not expressly specify which recording material/**ink/** to utilize

Tan et al. does not disclose the following:

*regarding claim 3, recording material/**ink**/ used for recording the positional information image comprises one of a pigment ink containing carbon and a dye ink containing carbon, and the recording material used for recording said other image comprises one of a carbon-free pigment ink and a carbon-free dye ink (col. 9, lines 7-24; allows for inks including dye or pigment and colorant is carbon-free; Tan et al. teaches using carbon free inks so not to interfere with NIRF [near infrared fluorescent] inks)

Although Silverbrook et al. and Tan et al. are analogous art because they are directed to a similar problem solving area of recording material/**ink**/ detection and recording material lack of detection.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to utilize a recording material of dye and pigment containing carbon; and recording material of dye and pigment being carbon-free as taught by Tan et al. into Silverbrook et al. for the purpose of ink detection and lack of detection based on specific properties (infrared detection).

Response to Arguments

5. Applicant's arguments filed 05 December 2005 have been fully considered but they are not persuasive.

In response to arguments on page 5 with respect to claim 1 [and dependent claims 2 and 4-9], applicant states Silverbrook (US 2002/0080396) does not disclose or describe recording a positional information image and tag [of Silverbrook] is not seen to describe recording a positional information image. However in paragraphs (0148, and 0218) Silverbrook discloses

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“The netpage printer receives subscribed netpage documents from netpage publication server 14.

Each document is distributed in two parts: the page layouts, and the actual text and image objects which populate the pages.” and;

A netpage consists of a printed page (or other surface region) invisibly tagged with references to an online description of the page. The tags may be printed on or into the surface of the page, may be in or on a sub-layer of the page or may be otherwise incorporated into the page. The online page description is maintained persistently by a netpage page server. The page description describes the visible layout and content of the page, including text, graphics and images. It also describes the input elements on the page, including buttons, hyperlinks, and input fields. The page descriptions of different netpages may share components, such as an image, although the netpages (and the associated page descriptions) are visibly different. The page description for each netpage may include references to these common components. A netpage allows markings made with a netpage pen on its surface to be simultaneously captured and processed by the netpage system.

In Silverbrook application *tags* make up the positional information image claimed in the current application. The *tags* provide information as to the relationship of “actual text and image objects” on the page [when a specified detector/netpage pen/ is used in conjunction with]. See also paragraphs 0150 and 0155.

In addition, applicants arguments with regards to Independent Claims 10, 11, 12, and 13 are rejected with respect to argument presented above in reference to Independent Claim 1.

In addition, applicants arguments with regards to Dependent Claim 310, 11, 12, and 13 is rejected with respect to argument presented above in reference to Independent Claim 1.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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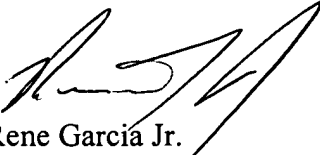
MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Communications with the USPTO

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rene Garcia, Jr. whose telephone number is (571) 272-5980. The examiner can normally be reached on M-F 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Rene Garcia Jr.
16 February 2006


K. FEGGINS
PRIMARY EXAMINER